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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,524	11/05/2001	John Doorbar	17746/1074	2747

29933 7590 05/18/2005

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EXAMINER

MOSHER, MARY

ART UNIT PAPER NUMBER

1648

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/008,524

Applicant(s)

DOORBAR, JOHN

Examiner

Mary E. Mosher, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-12 and 14-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12 and 14-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/314,268.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

10

## **DETAILED ACTION**

### ***Allowable Subject Matter***

Provided that double patenting issues are resolved, claims 1-5, 7-12, 14-64 would be allowable if the base claim were amended to "a method of diagnosing a precancerous lesion..." and the interpretation step were amended to recite "...thereby indicating a precancerous lesion..."

The following is a statement of reasons for the indication of allowable subject matter: According to the ordinary dictionary definition, "Detect" means "to discover, find out" while "diagnosis" means "the act or process of deciding the nature of a diseased condition by examination." In this case, the prior art cited in the previous office actions involved detecting E4 in precancerous lesions. However, the detection was not used in a process of deciding the nature of a diseased condition, or suggested as useful for deciding the nature of a diseased condition (with reasonable expectation of success). Therefore, while the prior art can be argued to anticipate claims to *detection* of precancerous lesions with E4 binding molecules, the prior art did not teach or suggest *diagnosis* of precancerous lesions.

### ***Double Patenting***

Claims 1-5, 7-12, 14-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,346,377, for reasons of record.

### ***Claim Rejections - 35 USC § 102***

Claims 1-5, 7, 8, 12, 14-30, 64 are rejected under 35 U.S.C. 102(b) as being anticipated by Palefsky et al. Applicant argues that the reference does not teach the interpretive step. However, the binding does indicate the presence of E4 protein expression, the vegetative viral DNA replication is inherent, and the binding does detect the precancerous lesion.

Claims 1-5, 7-12, 14-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Doorbar et al. See Figure 4. Applicant argues that the reference does not anticipate because the figure shows localization of E4 protein in a lesion known to be HPV16 positive, and argues that the reference does not even suggest that the molecules binding E4 are useful for detecting a precancerous lesion, and teaches away since only 1 of 16 biopsies stained positive of E4 expression. These arguments would be convincing if the claim were drawn to a method of diagnosis, however, the reference did succeed in detecting a lesion (even in a known sample).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. Mosher, Ph.D. whose telephone number is 571-272-0906. The examiner can normally be reached on M-T and alternate F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/16/05

  
MARY E. MOSHER, PH.D.  
PRIMARY EXAMINER